REMARKS/ARGUMENTS

At present, applicants' claims 1-28 stand rejection stand rejected under

35 U.S.C. § 101. Additionally, applicants' claim 29 stands rejected under 35 U.S.C. § 102(e)

based upon the patent to Robertazzi et al. (US Patent Number 6,370,560 issued April 9, 2002).

In light of the comments presented below both of these rejections are respectfully traversed.

Even though this is a rather late stage in the prosecution of the present application, it is

nonetheless thought that it would be a useful exercise to again present a summary of applicants'

invention and to particularly relate how applicants' invention is captured in the recited claimed

steps, particularly as exemplified in claim 1. To further assist the Examiner, the applicants'

invention is described in an analogous manner so that the Examiner may better appreciate the

invention and also may better be able to appreciate the differences between the claimed invention

and the art cited in the Robertazzi et al. patent. In the analogy, applicants' invention can be

likened to an expert system which is employed to help car buyers select models, features and

suppliers that best meet the car purchaser's requirements be they for power, traction or mileage

efficiency. In contrast, the patent to Robertazzi et al. can be likened perhaps to an expert system

which is used to run the engine of an already purchased and operating automobile to achieve

certain objectives such as low oil consumption or low fuel consumption. While both of these

systems may be couched in terms that are likenable to expert systems, applicants' invention in

this analogy is applied even before any particular automotive purchase is made. In contrast, in

this analogy, the invention described by Robertazzi et al. is only offerable in an already existing

and already running automobile. Accordingly, it is seen that applicants' claimed invention and

the patent to Robertazzi et al., although perhaps describable in some sense as both being expert

systems, they clearly seem to be very much distinct and related only by the fact that they are

directed to the subject of automobiles and/or in this analogy to computer systems.

More particularly, with respect to applicants' claimed invention, as clearly recited in applicants' specification, it is seen to be directed to the field of business solutions development and in particular to the provision of an automated method for evaluating particular aspects of information technology purchases and requirements therefor. It is seen that applicants' claimed invention is a method, system and program product that finds its most relevant use in the field of information technology consulting services. It is a method which is designed to address the problems associated with the growing complexities of managing corporate information technology infrastructures. Having said this, it is also noted that while this is the primary area in which applicants' invention is directed, it is nonetheless contemplated that the inventive techniques described by applicants can be and are readily applicable to the determination of any type of business solution offered by a solutions provider. As stated in applicants' specification, the sole limitation of the present invented process is the ability of the solution provider to glean the appropriate information from a potential customer at the appropriate point during the customer engagement process and to apply the obtained information in meaningful manner in which a set of available solutions and the data derived from previous customer engagements is stored in its knowledge base.

With specific reference to applicants' claim 1, it is seen that it is a method carried out in a data processing system for determining a cost differential resulting from migrating computational processing capacity from a first computer platform to a second computer platform. This method involves steps of providing, determining and deriving, all of which stem from information relating to usage on a first computer platform and a second computer platform and furthermore is based upon a determination of required processing capacity for the first and for the second computer platforms. Ultimately, applicants' claimed method results in a cost and capacity measurement for the first computer platform after migration and for the second computer platform also after migration. Accordingly, it is seen that applicants' claimed process produces useful, concrete and tangible results.

With these considerations firmly in mind, it is now appropriate to turn our discussions to the rejection of applicants' claims 1-29 under 35 U.S.C. § 101. Applicants' claim 1 can be likened very very favorably with the situation in the case of State Street Bank vs. (149 F.3d at 1373, 47 USPQ 2nd at 1601). In the State Street case, the transformation of data involved information representing dollar amounts. To the extent that the patentable subject matter under 35 U.S.C. § 101 involves the utilization of physical data, applicants' use of information such as required processing capacity is not as much a physical quantity as a rating of horsepower is for an automotive engine and is significantly more physical and tangible than dollar amounts. Likewise, it is just as much an expression and representation of a physical quantity as electrical signals employed to detect cardiac arrhythmias. Furthermore, it is just as much the utilization of a physical quantity as the coefficient of x-ray absorption associated with a volume of space is in a computed axial tomography imaging device. It is therefore seen that when compared with the claims in the State Street case, applicants' claims are equally if not more compellingly patentable in terms of working with and producing tangible results.

It is also noted that the final step in applicants' claim 1 produces a cost and capacity measurement for two computer platforms. It is precisely this information which potential users and/or purchasers of data processing equipment would find to be very useful. Accordingly, it is seen that not only does applicants' process produce a tangible result, it produces just as much a useful result as did the claims in the State Street Bank case. Furthermore, the results produced by applicants' method are both concrete and tangible. They are definitive, quantitative indicators that have instant applicability for information technology managers.

Furthermore, it is noted that the recited steps in applicants' claim 1 do not in anyway preempt any mathematical algorithms. As currently existing, applicants' claims specifically recite that it is directed to "a method carried out in a data processing system for determining a

cost differential resulting from migrating computational processing capacity...., the method comprising the steps of...". It is therefore seen that applicants' claim 1 recites a method, and furthermore recites that this method is carried out in a data processing system.

The claim preamble ends with a recitation that the method comprises certain steps. "The method that is referred to" is in fact the method that is carried out in a data processing system. Thus, applicants' claim 1 recites a method in which the claimed steps of combining, determining, deriving, determining and deriving occur or are carried out within a data processing system. There is no question that all of applicants' claim steps in the claims as amended in the previous response are carried out in a data processing system. Contrary to the Examiner's assertion, there is no need to, nor failure to incorporate or implement a data processing system into the main body of the claims. The fact that the claim transition language recites "the method comprising the steps of..." provides all of the linking that is necessary. The method that is referred to is a method which is carried out in a data processing system. Furthermore, the method that is recited indicates that it comprises steps. What comprises steps? Answer - the method. Where is the method carried out? Answer - in a data processing system. All of the relevant linkage and incorporation that may arguably be necessary is already present.

The Examiner is also in error in his characterization of applicants' claims as spelled out on page 2 of the above identified office action. In one instance, the Examiner indicates that it is the epitome of his rejection under 35 U.S.C. § 101 that applicants' claims lack utility. Clearly the knowledge of cost and capacity measurements for at least two different computer platforms would be very useful information to an information technology purchaser. Furthermore, this knowledge is not based upon abstract ideas but rather upon information provided which relates to specific hardware and real world parameters such as the horsepower or millions of instructions per second that a data processing system may be capable of providing. To the information

technology purchaser these are not abstract ideas at all. These are real world, down-to-earth measurements which such individuals would find extremely useful.

The Examiner further indicates that claim 15, which is the program product version of applicants' claim 1 is directed to an abstract idea. Nothing could be further from the truth. If the recitations found in applicants' claim 1 are directed to concrete, real-life, real world problems, then it is absolutely clear and uncontrovertible that the program product version of these steps is also both useful and concrete. Furthermore, it is seen that applicants' claimed invention does in fact advance the needs found by those working in the technological arts and, in particular, it is seen that applicants' claimed invention meets the needs of information technology managers and purchasers. It is irrelevant that some of the steps might be carried out by "mere human intervention". It is undeniable that the State Street Bank case referred to above likewise included steps that could be carried out by "mere human interventions". Nonetheless, the claims in this case were found to be perfectly acceptable by the court and the Examiner is decidedly in error by using as a rejection rationale an assertion that one or more steps could be carried out by a human being. Such a rationale was clearly repudiated in the case of the claims in the State Street Bank situation; it does not work here either.

Continuing to address in a seriatim fashion the Examiner's comments in the above identified office action, it is noted that on page 3 thereof the Examiner asserts that "although the program product itself could be concrete and tangible, it may fail to satisfy the 'utility' requirement if it merely contains the steps that involve human mental process and does not transform data corresponding to something in the real world." As repeatedly pointed out above, it is seen that applicants' claim 1 for example employs information such as required processing capacity for first and second computer platforms. This is as much a real world parameter as is the volume content of a 1 gallon jug, especially when compared to the actual amount of fluid in the jug, wherein the difference is a form of capacity measurement for holding more liquid. It is

therefore seen that applicants' program product claim as exemplified in claim 15 is not only concrete and tangible, it is extremely useful and is based upon real world parameters. And clearly it is seen that a computer readable medium containing program steps to carry out the process recited in claim 1 would be equally useful to an individual such as an information technology manager. Accordingly, it is seen that the Examiner's specific allegations with respect to applicants' claim 15 are inapposite and in error.

The Examiner also asks the applicants' to point out structural differences between the claimed invention and that which is described in the patent to Robertazzi et al. It is asserted that applicants' discussion above, with respect to the expert system analogies for the claimed invention and for the systems shown in Robertazzi et al. is sufficient to delineate and to point out the fact that the results of these two processes are extremely different. Accordingly, since the results are so different, and since the input is so different, it is clear that structural differences must and do exist. For example, it is seen that the structure of the process provided by the present applicants' produces cost and capacity measurements, as in an expert system model, which are useful to information technology managers who are making purchase decisions. In contrast, it is seen that the structure of the process described by <u>Robertazzi et al. at best describes how an already purchased data processing system may be operated</u>. Contrary to the Examiner's assertion, the prior art structure is not capable of performing the necessary steps for carrying out applicants' claimed invention. In particular, the processes of Robertazzi et al. are not intended, nor do they produce, cost and capacity measurements for different computer platforms. At best, Robertazzi et al. work within a single data processing system and merely work with resources that are available within that already existing system. <u>Robertazzi et al. is incapable of producing any information with respect to any data processing system other than the one that it exists on</u>. Accordingly, it is seen that the teachings of Robertazzi et al. are structurally and functionally significantly different in their operation and their result. It is therefore seen that applicants'

claimed invention and in particular applicants' claim 29 is not in any way anticipated by the patent issued to Robertazzi et al.

For all of the reasons above, it is clear that the Examiner's rejection of applicants' claims 1-29 under either 35 U.S.C. § 101 or under 35 U.S.C. § 102 cannot be sustained. It is accordingly therefore respectfully requested that both of these rejections be withdrawn.

It is noted that the present response does not amend applicants' specification or claims in any way. It is further noted that the present response does not require the payment of any additional fees. It is further noted that the present response is being made within the two-month interval provided in the regulations which produces for the Examiner a corresponding obligation to provide applicants with an advisory action before the three month date, which in this case is January 20, 2005.

Accordingly, it is now seen that all of the applicants' claims are in condition for allowance. Therefore, early notification of the allowability of applicants' claims is earnestly solicited. Furthermore, if there are any matters which the Examiner feels could be expeditiously considered and which would forward the prosecution of the instant application, applicants' attorney wishes to indicate his willingness to engage in any telephonic communication in

furtherance of this objective. Accordingly, applicants' attorney may be reached for this purpose at the numbers provided below.

Respectfully Submitted,

DEC. 16, 2004
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Date

~~Lawrence D. Cutter~~

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